

**REMARKS**

Claims 2-8, 10 and 12-89 are pending in the captioned Application in which claims 1, 2, 6-11, 19-22, 26-28 and 35-38 are rejected, in which claims 1, 9 and 11 are canceled hereby without prejudice, in which claims 29-33 are allowed, in which objected to claims 3, 12-14, 17, 18, 23 and 34 would be allowable if rewritten in independent form, and in which claims 4, 5, 15, 16, 24, 25 and 39-89 have been withdrawn by the Examiner under a provisional restriction requirement.

**Reconsideration of Restriction Requirement:**

Applicant hereby requests reconsideration of the Restriction Requirement in view of the response herein. In view of the patentability of generic independent claims 3, 12 and 23, the provisional restriction regarding claims 4, 5, 15, 16, 24 and 25 should be withdrawn because those claims are patentable at least because they depend from one of patentable claims 3, 12 and 23. In addition, claims 71-89 are directed to a belt scraper, of which claims 71 and 81 are generic, as are claims 2-8, 10 and 12-38 and so are properly within Group I and should be allowed for the reasons set forth herein regarding claims 2-8, 10 and 12-38.

Thus, all of claims 2-8, 10 and 12-38 and 71-89 are patentable and should be allowed.

**Objections:**

The drawing is objected to because it allegedly does not show a bushing having a funnel-shaped hole as recited in claim 10. Examiner's attention is directed to Figure 3 wherein item 30B is a bushing having a funnel-shaped hole shown in cross-section. The funnel-shape of the hole through bushing 30B is evident in the angled entry portion of the hole at the left end (as viewed in the drawing) thereof and in the cylindrical portion of the hole extending to the right thereof.

Confirmation of approval of the formal drawing in the next paper is solicited.

Claim 19 is objected to because "it appears that line 2 should read "with respect to the." Claim 19 is so amended. The Examiner is thanked for pointing out the informality.

Claims 3, 12-14, 17, 18, 23 and 34 are objected to as depending from a rejected base claim and would be allowable if rewritten in independent form. Claims 3, 12, 18, 23 and 34 are amended hereby to be rewritten in independent form and should be allowed. Objected to claims 13, 14 and 17 depending therefrom are therefore also allowable. The provisional withdrawal of claims 4 and 5 which depend from allowable claim 3, of claims 15 and 16 which depend from allowable claim 13, and of claims 24 and 25 which depend from allowable claim 23, should be withdrawn because each now depends from an allowable generic claim. Accordingly, claims 4, 5, 15, 16, 24 and 25 are identified as "original" in the claim listing submitted herein because they no longer should be withdrawn.

This amendment does not narrow the scope of any claim element or limitation and so is not limiting of any claim element or limitation, and Applicant reserves the right to the benefit of the doctrine of equivalents with respect thereto.

Accordingly, withdrawal of the objections and allowance of claims 3-5, 12-18, 23-25 and 34 is in order, and such action is solicited.

Rejection Under 35 U.S.C. §102(b):

1, 8-11, 19 and 21 are rejected under 35 U.S.C. §102(b) as being anticipated by US 4,925,434 to Swinderman et al. The rejection is traversed as to amended claims 8, 10, 19 and 21 and is moot as to canceled claims 1, 9 and 11.

Swinderman et al relates to a torsional tensioning device 10 for imparting torsional bias to shaft 15 for urging scraping blades 14 against a conveyor belt 16. Shaft 15 is tensioned by first and second hubs 48 and 64 and the elastomeric torsion sleeve 58 therebetween, and hub 48 is selectively connectable to shaft 15 and hub 64 is lockable to a stationary frame member. (Abstract; column 4, lines 13-45). Scraper blades 14 are removably secured to shaft 15 and engage conveyor belt 16. (Column 2, lines 37-41). As is visible in Figure 1 thereof, plural blades 14 appear to be mounted on arms extending from shaft 15. It is noted that Swinderman et al is directed to a torsional tensioner 10 for biasing a shaft 15 and does not describe or suggest either other tensioning arrangements or other blade mounting arrangements.

Applicant's claims 8, 10, 19 and 21 are patentable at least because they depend from patentable claim 2, which is patentable for the reasons set forth herein below. In addition, claim 10 recites a bushing having a funnel-shaped hole for receiving the blade holder, which is not described by Swinderman.

Accordingly, the rejection under 35 U.S.C. §102(b) is overcome and should be withdrawn.

Rejections Under 35 U.S.C. §103(a):

Claims 2, 6, 7, 20, 22, 26-28 and 35-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Swinderman et al in view of US 4, 838,409 to Rappen. The rejection is respectfully traversed.

Swinderman et al is discussed above, and it is again noted that Swinderman et al is directed to a torsional tensioner 10 for biasing a shaft 15 and does not describe or suggest any other tensioning arrangements or any other blade mounting arrangements.

Rappen relates to a scraper device for conveyor belts wherein a blade holder 5 having sprung arms (i.e. resilient or springy arms 7, 8) can be mounted to engage a bearing axle 2. Blade holder 5 carries scraper blades 6 at the end of the spring arms 7, 8 remote from the axle 2 to press blade 6 against a conveyor belt 1. (See Figure 1; Abstract; column 4, lines 38-57).

Rappen describes the disadvantages of torsional tensioning devices of the prior art, including their complicated construction which requires pre-assembly and that the angle of the pitch of the scraper blade changes as a consequence of wear and tear. (Column 1, lines 40-60). Rappen therefore teaches a scraper device having spring arms fashioned out of at least two parallel guide rods of resilient material, so that torsion springs can be dispensed with. (Column 2, lines 3-14).

Because Swinderman et al and Rappen teach away from each other, there is no basis for their combination, and there is no suggestion or motivation to do so. It is "error to find obviousness where [the] references `diverge from and teach away from the invention at hand.'" *In re Fine*, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988) citing *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983).

Moreover, the purported combination of Swinderman et al and Rappen is also improper under the law because neither reference suggests its combination with the other. Absent some statement or suggestion within the references themselves that they should be combined, there is no nexus which could substantiate the suggested combination.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so."

*ACS Hospital Systems, Inc. vs. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), 57 U.S.P.Q.2d 1161, 1166; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), 50 U.S.P.Q.2d 1614, 1618.

"[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."

*Ecolochem Inc. v. Southern California Edison*, 56 U.S.P.Q.2d 1065, 1076 (Fed. Cir. 2000) quoting *In re Rouffet*, 149 Fed.3d 1350, 1357 (Fed. Cir. 1998), 47 U.S.P.Q.2d 1453, 1456.

In addition, even if such combination could be made, it is submitted that the resulting structure would not be that of the claimed invention, but would just be the torsional tensioning arrangement 10 of Swinderman et al with the blade holder 5 and blade 6 of Rappen mounted on shaft 15 of Swinderman et al.

The Examiner admits that Swinderman et al "fails to disclose a blade body having a plurality of pairs of parallel skirts defining a blade cavity, while the blade holder is disposed in the blade cavity with the skirts releasable engaging the blade holder...." In fact, Swinderman et al does not suggest any substantially parallel skirts extending from a blade body for releasable engaging a blade holder.

Rappen does not disclose what Swinderman et al lacks. Rappen clearly differentiates

between a blade holder 5 having resilient arms 7, 8 and a blade 6 that is secured to blade holder 5, such as by inserts or attach grooves and springs. That the blades 6 may easily be exchanged strongly confirms that Rappen clearly separate blade 6 from blade holder 5. (Column 3, lines 28-55). The Examiner's assertion that Rappen discloses "a blade body having a pair of skirts defining a blade cavity while the blade holder is disposed in the blade cavity" is not supported by the Rappen reference, but is impermissible hindsight based upon the teaching of Applicant's invention.

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

*Uniroyal Inc. vs. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the "insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". *W. L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552, 1553, 220 U.S.P.Q. 303, 312, 313 (Fed. Cir. 1988).

Accordingly, Applicants' claim 2 is patentable because it recites"

"a blade holder;...

"a blade mounted on said blade holder; and ...

"wherein said blade comprises a blade body having a pair of substantially parallel skirts extending therefrom defining a blade cavity, wherein said blade is mounted on said blade holder with said blade holder disposed in said blade cavity with said skirts releasably engaging said blade holder,"

which is not described or suggested by Swinderman et al and/or Rappen, whether taken individually or properly combined.

Further, Applicants' claim 22 is patentable because it recites"

"a blade holder;

"a scraper blade having a blade body, a blade tip on one end of said blade body and a pair of skirts extending from an end of said blade body opposite the blade tip, wherein said pair of skirts are flexible and define a blade cavity for receiving and engaging said blade holder;

"wherein said scraper blade is mounted on said blade holder with said blade holder disposed in said blade cavity with said skirts releasably engaging said blade

holder,”

which is not described or suggested by Swinderman et al and/or Rappen, whether taken individually or properly combined.

Applicant's claims 6, 7, 20, 26-28 and 35-38 are patentable at least because they depend from one of patentable claims 2 and 22. Rappen is seen to be silent regarding longitudinal movement of blades 6 in blade holder 5, and the arrangement of hub 4 and projections 10 therein appears to be for restricting rotational movement between axle 2 and hub 4 and is not described as restricting longitudinal movement. In addition, Applicants claims 6, 26 and 37 recite complementary engaging features for limiting or constraining longitudinal movement of the blade with respect to the blade holder, and claims 7, 27 and 38 recite plural engaging features whereby the blade may be indexed in a plurality of longitudinal positions, none of which are described or suggested by Swinderman et al and/or Rappen, whether taken individually or in proper combination.

Accordingly, the rejection under 35 U.S.C. §103(a) is overcome and should be withdrawn.

Conclusion:

Applicant respectfully requests that the objections and rejections be withdrawn, and that the Application including claims 2-8, 10 and 12-89 be allowed and passed to issuance.

Enclosed is a check in the amount of \$126.00 in payment of the fee for increasing the number of independent claims by three. The number of claims remaining being the same as or less than the number previously paid for, no fee is due therefor in consequence of this timely filed response.


Should any other or additional fee be due in consequence of this response, please charge such fee and deposit any refund to Deposit Account 04-1406 of Dann, Dorfman, Herrell & Skillman.

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The Examiner is requested to telephone the undersigned attorney if there is any question or if prosecution of this Application could be furthered by telephone.

Respectfully submitted,  
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